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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,522	01/12/2004	Jose Miguel Menendez	0721.102.US	8263
36139 7590 04/06/2007 EPSTEIN & GERKEN 1901 RESEARCH BOULEVARD SUITE 340 ROCKVILLE, MD 20850			EXAMINER SAFAVI, MICHAEL	
			ART UNIT	PAPER NUMBER
			3673	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/06/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/754,522

Applicant(s)

MENENDEZ, JOSE MIGUEL

Examiner

M. Safavi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 and 26-32 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,8,16-18,26,30 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,7,9-15,27-29 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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The terminal disclaimer filed on January 12, 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,698,155 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to, which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 7, 9-15, 27-29, and 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not appear to have originally disclosed, "said constriction having a width...of substantially one-third said overall width" as now appears recited in **claim 1**. The specification does not appear to have originally disclosed, "said overall width is substantially one-half said overall height" as now appears recited in **claim 4**. The specification does not appear to have originally disclosed, "said arms...define an included angle of substantially 70 degrees" as now appears recited in **claim 12**. The specification does not appear to have originally disclosed, "said constriction has a height of substantially 4.2 cm" as now appears recited in **claim 15**. The specification does not appear to have

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originally disclosed, "each of said arms defining an angle of substantially 35° with said constriction axis" as now appears recited in **claim 27**.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Claim 7**, lines 1-3, the recitation that "said tips terminate at side edges and said planar portions respectively extend from said outer corners to said side edges" is vague, indefinite, and confusing because the planar portions of the side flanges (918, 920) actually terminate at the outside corners (923, 925) and NOT as the side edges (928, 930) of the tips (929, 931).

Applicant's arguments with respect to the above rejection have been reviewed but are not convincing. Initially, Applicant makes reference to Figs. 1 and 2 of the instant disclosure when an election to prosecute Fig. 23 had been made on July 19, 2006. Further, the "tips" are defined as contained in a plane parallel to the plane of the apex. As such, the side flange does not extend to side edges of the tip. It has been noted that Applicant, in the response filed July 19, 2006, has listed claim 7 as reading upon the elected species of Fig. 23.

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-4, 7, 9-11, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by KAMM (U.S. Patent No. 5,592,786).**

**As to claim 1, KAMM discloses a building element (12 in Fig. 1) comprising:**

a profile (12) extending lengthwise between first and second ends (28, 30) said profile (12) having a substantially uniform cross-section defined by a web (20), a pair of side flanges (16, 22) extending perpendicular to said web (20), and outer corners respectively joining said side flanges (16, 22) to said web (20), said web (20) having a constriction (32), a pair of planar segments (portions of 20 above and below 32) respectively disposed on opposite sides of said constriction (32), and inner corners respectively joining said planar segments (portions of 20 above and below 32) to said constriction (32), said constriction (32) including a pair of arms (34, 36) extending angularly inwardly from said inner corners, respectively, to a curved base (between 34 and 36) having an apex contained in a plane, said planar segments (portions of 20 above and below 32) having outer surfaces, respectively, contained in a plane parallel to said plane of said apex, said side flanges (16, 22) respectively extending from said outer corners in the

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same direction as said constriction (32) to tips (18, 24), respectively, contained in a plane parallel to said plane of said apex, said building element (12) having an overall width between said plane of said planar segments (portions of 20 above and below 32) and said plane of said tips (18, 24), said constriction (32) having a width between said plane of said planar segments (portions of 20 above and below 32) and said plane of said apex about one-third said overall width (in Fig. 3, 32 appears to have a width which is "*about*" one-third the overall width of 12).

**As to claim 2,** KAMM discloses the building element (12) of claim 1 as discussed above, and KAMM also discloses that said side flanges (16, 22) include planar portions, respectively, having outer surfaces contained in parallel planes perpendicular to said plane of said planar segments (portions of 20 above and below 32), and said building element (12) has an overall height between said planes of said planar portions.

**As to claim 3,** KAMM discloses the building element (12) of claim 2 as discussed above, and KAMM also discloses that said constriction (32) is bisected by a constriction axis perpendicular to said plane of said planar segments (portions of 20 above and below 32) and said constriction axis is centrally located along said overall height of said building element (12).

**As to claim 4,** KAMM discloses the building element (12) of claim 3 as discussed above, and KAMM also discloses that said overall width is about one-half said overall height (in Fig. 3, it appears that the overall width is "*about*" one-half the overall height).

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**As to claim 7** (and as best understood despite the 35 U.S.C. 112, second paragraph, indefiniteness discussed above), KAMM discloses the building element (12) of claim 2 as discussed above, and KAMM also discloses that said tips (18, 24) terminate at side edges on one side and at a second outer corner on the other side and said planar portions (16, 22) respectively extend from said outer corners to said second outer corner.

**As to claim 9**, KAMM discloses the building element (12) of claim 2 as discussed above, and KAMM also discloses that said planar portions (16, 22) respectively extend from said outer corners to said tips (18, 24) and said tips (18, 24) include end flanges (18, 24) extending from said planar portions (16, 22), respectively, inwardly toward one another.

**As to claim 10**, KAMM discloses the building element (12) of claim 9 as discussed above, and KAMM also discloses that said end flanges (18, 24) extend linearly from said planar portions (16, 22), respectively, perpendicular to said planar portions (16, 22) and parallel to said planar segments (portions of 20 above and below 32).

**As to claim 11**, KAMM discloses the building element (12) of claim 10 as discussed above, and KAMM also discloses that said planar portions (16, 22) are joined to said end flanges (18, 24) by curved outside corners, respectively.

**As to claim 14**, KAMM discloses the building element (12) of claim 1 as discussed above, and KAMM also discloses that said arms (34,36) are joined to said inner corners at junctions, respectively, and said constriction (32) has a height between said junctions no greater than one-fourth said overall height (in

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Fig. 3, 32 appears to have a height which is “*no greater than*” one-fourth the overall width of 12).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 12, 13, 15, 27-29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over KAMM (U.S. Patent No. 5,592,786).**

**As to claim 12, KAMM discloses the building element (12) of claim 1 as discussed above, and KAMM also discloses that said arms (34, 36) extend linearly from said inner corners to said base.**

**KAMM fails to explicitly disclose that the arms define an included angle of about 70 degrees.**

However, it is well settled that changes in size/proportion (i.e., dimensions) do not constitute a patentable difference. See *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package “of appreciable size and weight requiring handling by a lift truck” where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); *In re Rinehart*, 531 F.2d 1048, 189



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USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Therefore, it would have been an obvious expedient to one of ordinary skill in the art at the time the invention was made to modify the building element of KAMM by making the included angle between the arms of the constriction be about 70 degrees in order to form an optimum angle of the strengthening rib sidewalls along the webbing of the channel member and also because changes in size/proportion (i.e., dimensions) do not constitute a patentable difference.

**As to claim 13**, KAMM discloses the building element (12) of claim 12 as discussed above, and KAMM also discloses that said inner corners are curved and said outer corners are curved.

**As to claim 15**, KAMM discloses the building element (12) of claim 14 as discussed above.

KAMM fails to explicitly disclose that said constriction has a height of about 4.2 cm.

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However, it is well settled that changes in size/proportion (i.e., dimensions) do not constitute a patentable difference. See *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package “of appreciable size and weight requiring handling by a lift truck” where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) (“mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled.” 531 F.2d at 1053, 189 USPQ at 148.). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Therefore, it would have been an obvious expedient to one of ordinary skill in the art at the time the invention was made to modify the building element of KAMM by making the constriction have a height of about 4.2 cm in order for the height of the constriction to be commensurate with the desired included angle of the constriction, depending upon the size of the channel, and also because changes in size/proportion (i.e., dimensions) do not constitute a patentable difference.

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**As to claim 27, KAMM discloses a building element (12) comprising:**

a profile (12) extending lengthwise between first and second ends (28, 30), said profile (12) having a substantially uniform cross-section defined by a web (20), a pair of side flanges (16, 22) extending perpendicular to said web (20), and outer corners respectively joining said side flanges (16, 22) to said web (20), said web (20) having a constriction (32) bisected by a constriction axis parallel to said side flanges (16, 22), a pair of web segments (portions of 20 above and below 32) respectively disposed on opposite sides of said constriction (32), and inner corners respectively joining said web segments (portions of 20 above and below 32) to said constriction (32), said constriction (32) including a pair of arms (34, 36) extending linearly and angularly inwardly from said inner corners, respectively, to a curved base (between 34 and 36).

KAMM fails to explicitly disclose that each of said arms define an angle of about 35° with said constriction axis.

However, it is well settled that changes in size/proportion (i.e., dimensions) do not constitute a patentable difference. See *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package “of appreciable size and weight requiring handling by a lift truck” where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) (“mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a

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Therefore, it would have been an obvious expedient to one of ordinary skill in the art at the time the invention was made to modify the building element of KAMM by making each of the arms of the constriction define an angle of about 35° with the constriction axis in order to form an optimum angle of the strengthening rib sidewalls along the webbing of the channel member and also because changes in size/proportion (i.e., dimensions) do not constitute a patentable difference.

**As to claim 28**, KAMM discloses the building element (12) of claim 27 as discussed above, and KAMM also discloses that said web segments (portions of 20 above and below 32) are planar

**As to claim 29**, KAMM discloses the building element (12) of claim 27 as discussed above, and KAMM also discloses that said constriction axis is centrally located between said side flanges (16, 22).

**As to claim 31** (and as best understood despite the 35 U.S.C. 112, second paragraph, indefiniteness discussed above), KAMM discloses the building element (12) of claim 27 as discussed above, and KAMM also discloses

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that said tips (18, 24) include end flanges (18, 24) angled (at 90 degrees) from said side flanges (16, 22), respectively.

### ***Response to Arguments***

Applicant's arguments filed January 12, 2007 have been fully considered but they are not persuasive. Applicant basically argues that the applied prior art to Kamm '786 does not disclose a "structural steel building element". Examiner does not agree that Kamm '786 does not disclose a "structural steel building element". Kamm, indeed, is a structural member formed of steel that is used and can be used to hold applied loads of any given degree or amount. The language of the rejected claims does not serve to define over what is disclosed by Kamm '786 either alone or as modified. And, any modifications made to Kamm are tenable with motivation and teachings, (expressed by Kamm or taken from general knowledge and teachings within the art), supported by the above rejection under 35 U.S.C. 103.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory

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action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (571) 272-7046. The examiner can normally be reached on Mon.-Thur., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Engle can be reached on (571) 272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



MICHAEL SAFAVI  
PRIMARY EXAMINER  
ART UNIT 3673

M. Safavi  
March 28, 2007